

10/018,154



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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Kai Desinger	Examiner:	Charles Alan Marmor II
Serial No.:	10/018,154	Group Art Unit:	3736
Filing Date:	April 8, 2000	Docket No.:	2454
Title	Surgical Probe for Minimally Invasive Tissue Removal		

Date of Deposit: 10-16-04

I hereby certify that this paper is being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450

Signature: Mary S. Keller

Printed Name: Mary S. Keller

Declaration of Kai Desinger Under 37 C.F.R. § 1.131

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Sir:

1.) I, Kai Desinger, am the named applicant of the above-identified application for patent. I am the sole inventor of the subject matter described and claimed in the above-identified application and I executed a Declaration to that effect, enclosed herewith. As stated in the Declaration, this application claims the benefit of priority under 35 U.S.C. § 119 to PCT application EP00/03146, filed April 8, 2000 and to German application DE 19927650.1, filed June 17, 1999.

2.) I have been advised that the United States Patent & Trademark Office in an Office Action dated April 6, 2004 rejected certain claims of the above-identified

application by applying the teachings of U.S. Pat. No. 6, 454,727 to Burbank (Burbank '727). The Burbank patent was filed on November 20, 1998. The Burbank patent claims priority to U.S. Pat. No. 6,331,166, filed April 8, 1998 and to U.S. provisional application 60/076,973, filed March 3, 1998.

3.) Prior to March 3, 1998, I completed in Germany, a WTO member country, the invention described and claimed in claims 1-3 in this application. More particularly, prior to March 3, 1998, I conceived of and reduced to practice a surgical hollow probe for minimally invasive tissue removal, comprising an elongate hollow body, an opening in the region of the distal end of the hollow body for receiving tissue, and an electrically conductive ring-shaped or loop-shaped cutting element which can be extended from the hollow body and which can be applied to an HF-voltage source, for electrosurgically cutting out tissue in the area around the distal opening of the hollow body, characterized in that the cutting element can be extended from or pivoted out of the hollow body transversely with respect to the longitudinal axis of the hollow body and is then displaceable outside the hollow body along the hollow body.

4.) Further, prior to March 3, 1998, I conceived of and reduced to practice a surgical hollow probe for minimally invasive tissue removal, comprising an elongate hollow body, an opening in the region of the distal end of the hollow body for receiving tissue, and an electrically conductive ring-shaped or loop-shaped cutting element which can be extended from the hollow body and which can be applied to an HF-voltage source, for electrosurgically cutting out tissue in the area around the distal opening of the hollow body, characterized in that the cutting element can be extended from or pivoted out of the hollow body transversely with respect to the longitudinal axis of the hollow body and is then displaceable outside the hollow body along the hollow body, wherein the cutting element can be extended or pivoted out of the hollow body in a plane which extends transversely with respect to the longitudinal axis of the hollow body and is displaceable in parallel relationship with the longitudinal axis of the hollow body.

5.) Still further, prior to March 3, 1998, I conceived of and reduced to practice a surgical hollow probe for minimally invasive tissue removal, comprising an elongate hollow body, an opening in the region of the distal end of the hollow body for receiving tissue, and an electrically conductive ring-shaped or loop-shaped cutting element which can be extended from the hollow body and which can be applied to an HF-voltage source, for electrosurgically cutting out tissue in the area around the distal opening of the hollow body, characterized in that the cutting element can be extended from or pivoted out of the hollow body transversely with respect to the longitudinal axis of the hollow body and is then displaceable outside the hollow body along the hollow body, wherein the distal opening extends in the longitudinal direction of the hollow body along the path of displacement travel of the cutting element.

6.) My conception and reduction to practice of the invention as described above in Paragraphs 3-5 are documented in contemporaneous notes in my laboratory notebooks. Exhibit A to this Declaration is a page dated December 19, 1998 on which I have drawn by hand and annotated in my handwriting a device having the properties described above in Paragraphs 3-5 and in pending claims 1-3. Exhibit B to this Declaration is a page dated January 5, 1998 showing photocopies of four photographs of a prototype of a device having the properties described above in Paragraphs 3-5 and in pending claims 1-3. Exhibit C, dated February 27, 1998, shows additional view of the device drawn by my hand and annotated in my handwriting. I respectfully submit that these pages evidence conception at least as early as December 19, 1998 and reduction to practice at least as early as January 5, 1998. Therefore, I completed the invention prior to Burbank's earliest priority date of March 3, 1998. My conception and reduction to practice occurred in Germany, a WTO member country.

7.) I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and

further, that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patents issuing thereon.

Dated: September 30, 2004

By: _____

K. Desinger

Kai Desinger, PhD

Kai. Desinger Laborbuch Nr. 3 16.12.1937

16.12.37

- Frühlingsbesprechung
- Besuch Schmitt 18-19.12. 18.12. - 14:00 Uhr (G.H.L. 73)
- Prüfstellung fertig! endet diese Jahr nach 17.12.!
- EU - Antee LIFE (15.12.1937)
- Auftrag für Vorbereitung 1. Gesamtvolume 900 DM!
- Dr. Hülse

18.12.37

- Auftrag A. f. - Prof. H. S. Tel 8955 30.11
- Wegen U. - Anp. anw.
- RF - Konzept entwickeln

19.12.37

- Konzept zur Gewebseinführung mit HF-Elektrode

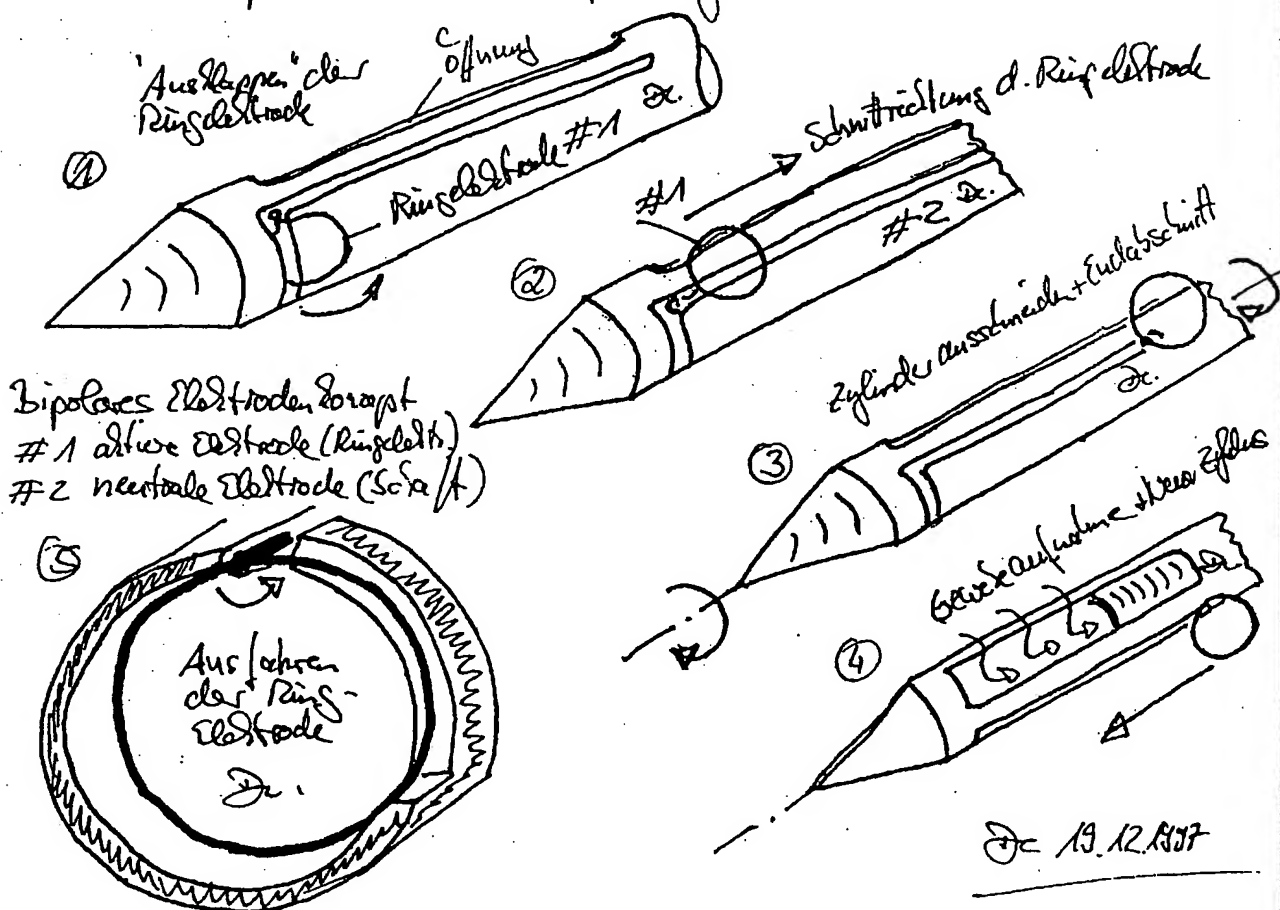


Exhibit B

2. 5. Januar 1998

Prototypen-Lan



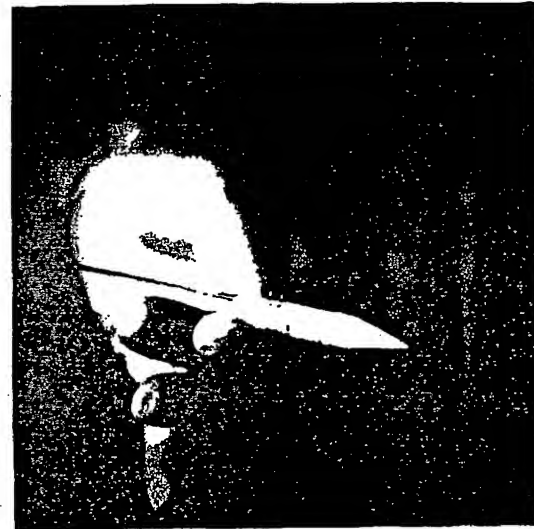
1.

5/98

① Ausgangspunkt der Angelegenheit

1.1.98

② Aufnahme d. Regelkarte unter HZ
Einschneide d. ...



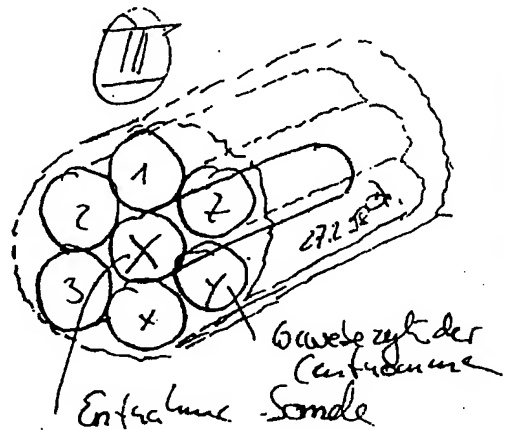
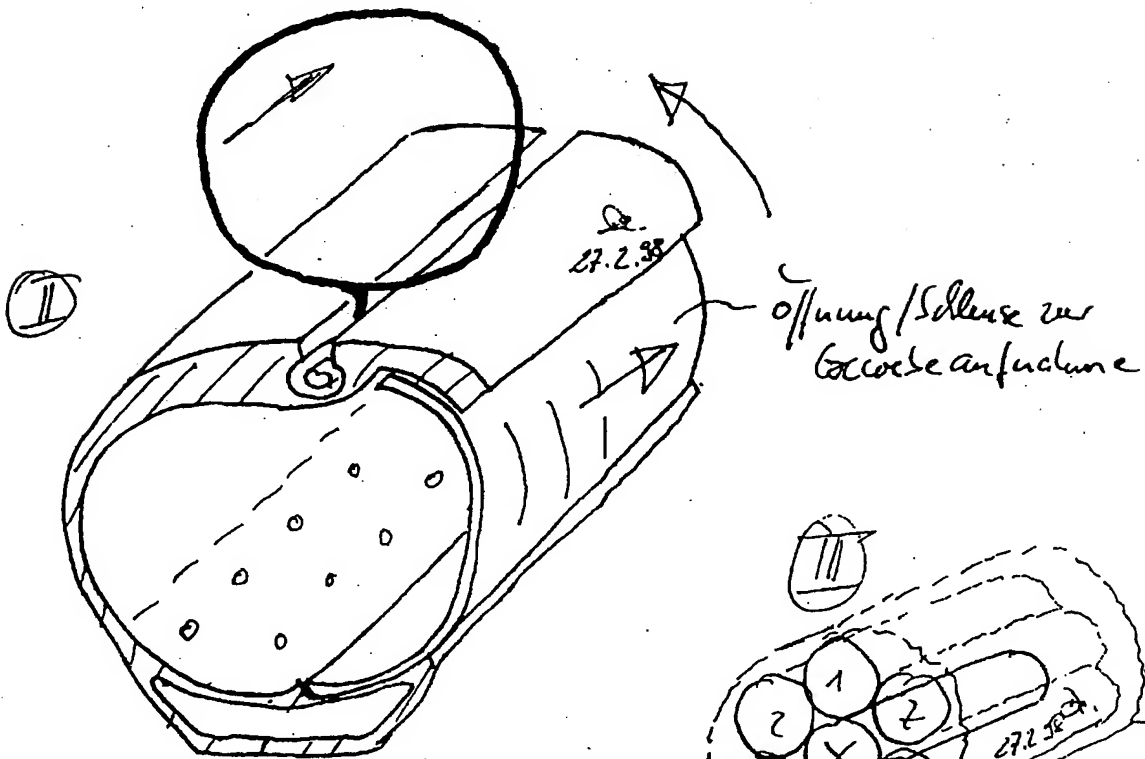
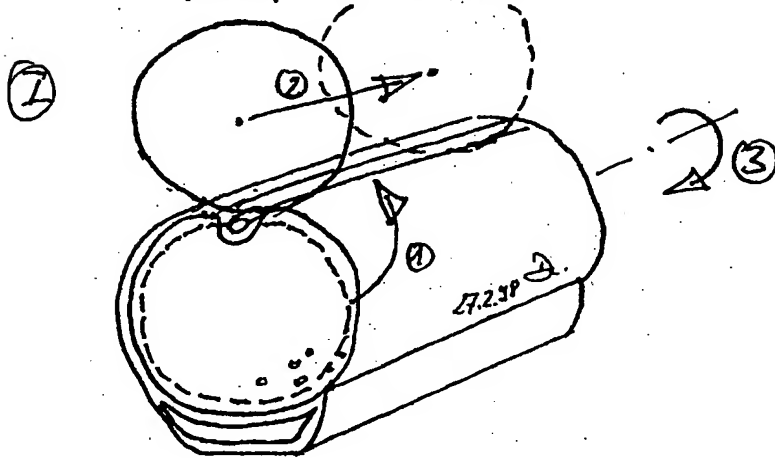
③ ...

④ ...

4

27.2.98

Konzept zur Gewebekontrolle / Biopsie (nach 19.12.97 Entwurf)



Zylindrisches Entnahmevolumen
nach 360°-Entnahme von
i- Gewebekylindern!